REMARKS

This is a response to the Advisory Action dated February 24, 2004 in which the Examiner declined to enter the Amendment dated January 7, 2004. Reconsideration of the claims based on the remarks provided below is respectfully requested. Claims 1 to 72 and 105 to 125 have been canceled without prejudice and claim 149 has been added so that claims 73 to 104 and 126 to 149 are pending.

Applicant reiterates his appreciation for Examiner Morgan and Supervisory Examiner Thomas' time and consideration during the telephonic interview with applicant's attorney, Cheryl Milone Bab, on December 21, 2003. The restriction requirement was discussed as to whether the requirement was properly presented in a final office action. Applicant's attorney argued that the newly added claims included recitations found in the originally added claims so that the restriction should not be presented in a final office action. The Examiners agreed to reconsider the restriction requirement. Also discussed was the obviousness rejection of claims 1 to 72 under 35 U.S.C. 103 based on U.S. Patent No. 5,991,731 to Colon et al and U.S. Patent No. 6,171,112 to Clark et al. Applicant agreed to add language to the claims as follows: "adding the at least one of medical and personally identifying information to a database of at least one individual available for recruitment" and "the authorized individual being a person with permission to receive information from the database." This language has been added in whole or part to the pending claims 72 to 104 and 126 to 149 in this amendment. The Examiners agreed to reconsider the obviousness rejection.

This preliminary amendment is also in response to the Office Action dated October 7, 2003 since the Amendment dated January 7, 2004, which responded to the October 7 Office Action, was not entered. In the October 7, 2003 Office Action, the Examiner set forth a restriction requirement regarding claims 1 to 72 as a first group and claims 73 to 149 as a second group. In the January 7, 2004 Amendment, applicant attempted to traverse the restriction requirement. This argument was rejected by the Examiner in the Advisory Action. Therefore, applicant cancels without prejudice claims 1 to 72 in order to pursue claims 73 to 104 and 126 to 148 and newly added claim 149 (which depends from claim 73) in this application. This action is taken without

prejudice to pursue the canceled claims in another prosecution. In addition, applicant continues to traverse the restriction requirement but in the interest of advancing the prosecution of this case, is pursuing claims 73 to 104 and 126 to 149.

Also, based on the December 21, 2003 interview with Examiner Morgan and Supervisory Examiner Thomas, applicant provides substantive amendments to the pending claims. More particularly, independent claims 73, 131, 132, 134, 138, 141, 143 and 147 have been amended to more clearly recite the invention. Multiple dependent claims have also been amended. Support for the claim amendments is as follows:

(a) Claims 73, 131, 132, 134, 138, 141 and 143, the "volunteer database" element: the specification as originally filed, claim 20 recited a list of volunteers, claim 31 recited the release of medical data, claim 34 recited data entered, claims 38 and 45 recited data stored in a memory, claim 46 recited retrieving data, on page 6, lines 12 to 14 is described entering data, on page 7, lines 16 to 17 is described storing the data in a memory device and on page 8, lines 23 to 24 is described a database of volunteers.

(b) Claim 89, the "authorized individual" element, the specification as originally filed, on page 8, line 23 to page 9, line 9 is described the process of becoming an authorized officer of a clinical study.

(c) Claims 96, 102 and newly added 149, the "opt-out" process, the specification as originally filed, e.g., claim 20, on page 8, lines 10 to 23 is described the opt-out procedure.

(d) Claim 141, the specification as originally filed, claim 1.

(e) Claims 103, 104, 134, the "clinical trials" examples, the specification as originally filed claim, on page 4, lines 16 to 18 is described different types of clinical trials, on page 6, lines 24 to 26 is described how various clinical trial administrators can alter the data requested in the recruiting process, on page 8, lines 23 to 25 is described how various researchers or administrators

of clinical trials can access the database, on page 10, lines 3 to 5 is described multiple clinical studies which have access to the volunteer database, Figure 3f, question 12.

(f) Claims 73, 131, 132, receiving medical or personal information, the originally filed specification, Figure 3a to 3f.

The Examiner did not analyze claims 73 to 104 and 126 to 148 previously because based on the restriction requirement, he withdrew them from consideration. Nevertheless, applicant takes this opportunity to argue that the cited prior art, i.e., U.S. Patent No. 5,991,731 to Colon et al, U.S. Patent No. 6,171,112 to Clark et al, U.S. Patent No. 6,272,470 to Teshima and arguments for which the Examiner has taken official notice, alone or in combination, does not teach the elements of any of the claims 73 to 104 and 126 to 149. However, each independent claim has been further amended and such amendments more clearly demonstrate the differences between the invention as claimed and the prior art. More particularly, each of claims 73, 131, 132, 134, 138, 141 and 143 recites adding either medical or personally identifying information about the individual to a database of recruits/volunteer or a database including such information. This element is not taught by any of the cited prior art references. Claim 147 is directed to analyzing information in a database. This element also is not taught by any of the cited prior art references.

Since at least one element of each of the independent claims (and likewise the claims which depend from them) are not taught by the cited prior art, applicant respectfully submits that each of the presently pending claims is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

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Respectfully submitted,

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